



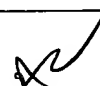
# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,675	11/27/2001	Masao Okubo	216132US2	8021
28970	7590	12/01/2004	EXAMINER	
SHAW PITTMAN IP GROUP 1650 TYSONS BOULEVARD SUITE 1300 MCLEAN, VA 22102			NGUYEN, TRUNG Q	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/993,675	OKUBO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Trung Q Nguyen	2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on amendment filed on 06/14/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2, 4-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Eldridge et al. (U.S. 5,974,662).

Regarding claims 2, 10 and 15-16, Eldridge et al. disclose in Figures 1-2 and in Column 12, lines 37-65 a probe card has a structure where nickel alloy is applied to the surface of a core material made of palladium alloy or beryllium copper alloy (column 12, lines 47-55).

Note: Limitations "a wire drawing operation with a wire-drawing die is performed" are considering as a "product by process", therefore, the above limitations will have any patentable weight. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Regarding claim 4, Eldridge et al. disclose in column 12, lines 37-45 the non-oxidizable film herein terms are gold, platinum, rhodium, palladium, iridium, etc., and these metals are elements which are thermally diffused into tungsten via upper-most

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surface of probe. Wherein a wire drawing operation is performed (column 12, lines 37-65).

Claims 5-9, 11-14 and 16 add the limitation wherein the probe diameter is 65 micrometer, nickel alloy plating is 3-15 micrometer, old plating is about 0.2-1.0 micrometer etc. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the probe diameter, thickness of nickel or gold plating dimension to receive the above measurements because it has been held that changes in shape and size are a matter of obvious design choice, absent any persuasive evidence that the change in configuration was significant.

### Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trung Nguyen whose telephone number is **(571) 272-1966**. The examiner can normally be reached on Monday through Friday, 8:30AM – 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cuneo Kamand can be reached at **(571) 272-1957**.

*Trung Nguyen*

Patent Examiner

Group Art Unit 2829

November 23, 2004

*Michael J. Tokar*  
Michael Tokar  
Supervisory Patent Examiner  
Technology Center 2800